



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,042	08/28/2001	Mark A. Conkling	5051.471	4291

20792 7590 08/05/2004

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

547.

Advisory Action

Application No.

09/941,042

Applicant(s)

CONKLING ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 77 and 78.

Claim(s) objected to: _____

Claim(s) rejected: 1, 5-10, 74-76 and 79-85.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Continuation of 2. NOTE: New issues:

112, 1st, enablement: The specification does not teach nucleic acids encoding Nic gene products. The sequence of the NtQPT1 coding sequence is not taught, nor is the Nic2 gene product; Nic gene products from other tobacco or nicotine-producing plants are not taught. 112, 1st, written description: The specification does not describe nucleic acids encoding Nic gene products. It is also not clear how one would use the claimed nucleic acids and plants transformed with them.

Objection: Claim 76 is broader than claim 1, upon which it depends.

The recitation "SEQ ID NO:1 operably linked to a Nic gene product" would require a new search for prior art under 102 and 103.

Continuation of 3. Applicant's reply WOULD HAVE overcome the following rejection(s):

Objection to claim 8;

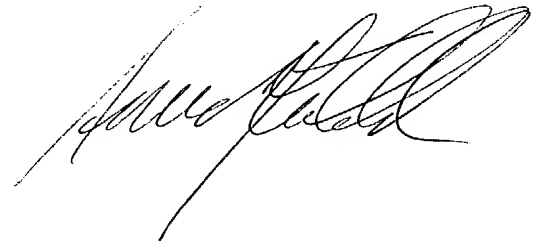
Double patenting because 5,837,876 has no claims to SEQ ID NO:1 operably linked to a Nic gene product.

Continuation of 5. does NOT place the application in condition for allowance because:

112 1st, Enablement: Applicant urges that the claims are enabled because nucleic acids containing at least one transcription factor binding sequence are taught in SEQ ID NO:1 (response pg 7). This is not found persuasive; the specification does not teach nucleic acids encoding Nic gene products. Applicant urges that the specification recites that sequence similarity can be determined by maximizing matching and that slight or non-consequential sequence variations mean that similar sequences are functionally equivalent (response pg 7-8). This is not found persuasive: The specification does not teach which sequence variations are non-consequential and teaches promoters with 95% identity to SEQ ID NO:1.

112, 1st, Written Description: Applicant urges that rejection of an original claim for lack of written description should be rare (response pg 8-9). This is not found persuasive. Just because such a rejection should be rare does not mean it should not be made when appropriate. The specification does not describe nucleic acids encoding Nic gene products and does not describe promoters with 95% identity to SEQ ID NO:1.

102(b) over WO 97/05261: Applicant urges that fails to disclose and isolated nucleic acid comprising SEQ ID NO:1 operably linked to a Nic gene product (response pg 10). This is not found persuasive because Conkling et al teaches such a nucleic acid on pg 17, paragraph 2.



**ANNE KUBELIK
PATENT EXAMINER**